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EXAMINER

DIVECHA, KAMAL B

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2451

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/913,885	Applicant(s) TISSERAND ET AL.	
	Examiner KAMAL B. DIVECHA	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Action is in response to communications filed 10/3/08.

Claims 1-7, 10-16 are pending in this application.

Claims 8-9 were previously withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), **was filed 10/3/08** in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **10/3/08 has been entered.**

Response to Arguments

Applicant's arguments filed in the communications have been fully considered but they are not persuasive.

In response filed, applicant argues in substance that:

- a. Lindsay et al. does not teach or fairly suggest that **such a termination** occurs once a user message has been communicated, the terminating step being triggered by the communication of the user message, as recited in claim 1 (remarks, pg. 7-8).

In response to argument [a], Examiner respectfully disagrees.

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Independent claim 1 recites:

A method of sending a user message through a transmission network, comprising the steps of:
activating a request to set up a call channel;
placing a user message in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field;
performing a signaling stage including sending said signaling message; and
terminating the set up of the call channel once the user message has been communicated without establishing a call, the terminating step being triggered by the communication of the user message.

In response filed, **applicant admitted** that Lindsay et al. discloses that a network releases a connection **in progress or during link set-up**. Such a release may be initiated by the network, or, result from authentication rejection, e.g. remarks, pg. 7, however, asserts that such a termination does not occur once a user message has been communicated...

Applicant specification discloses:

“According to a second essential characteristic of the invention, the microprocessor 7 causes the call set-up to terminate once the message 4 has been received by the called party and/or once a reply to the message 4 has been received by the caller. That is to say that, if the telephone 1 transmits a message 4 and does not await a reply **from the center 13, then said center can terminate call set-up**. If, however, a reply is awaited by the telephone 1 (since, in this example said telephone is the transmitter of the user message), then it is the telephone that must terminate call set-up...”

Lindsay explicitly teaches the process of terminating the call-set up can be triggered and/or initiated by both the user and the base station, e.g. col. 26 L1-30, reproduced herein.

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TABLE 9-2

	Direction
<u>Call Establishment Messages</u>	
CC-SETUP	Both
CC-INfOrmation	Both
CC-CALL-PRoCeeding	Network -> User
CC-ALERTING	Both
CC-PRoGress	Network -> User
CC-CONNECT	Both
CC-CONNECT-ACKnowledge	Both
CC-EMERGENCY-SETUP	User -> Network
CC-CALL-CONFIRMED	User -> Network
<u>Call Release Messages</u>	
CC-DISConnect	Both
CC-RELEASE	Both
CC-RELEASE-COMplete	Both
<u>Call Related Supplementary Services</u>	
HOLD	User -> Network
HOLD -ACKnowledge	Network -> User
HOLD-REJECT	Network -> User
RETRIEVE	User -> Network
RETRIEVE -ACKnowledge	Network -> User
RETRIEVE -REJECT	Network -> User
<u>DTMF Interaction</u>	
Start-DTMF	User -> Network
Stop-DTMF	User -> Network
Start-DTMF-ACK	Network -> User
Stop-DTMF-Ack	Network -> User
Start-DTMF-Reject	Network -> User

As admitted by the applicant above, the call release messages can be initiated during a link set up and/or when the connection is in progress.

In other words, the user and/or the base station/center/device can terminate the connection at any time during the call set up procedure without establishing a call.

In an event, the primary goal is to transmit/send the signaling message [with a user message], it would be a common sense thing and/or obvious to one of ordinary skilled in the art to terminate the set-up of the call simply because the intention was to transmit the signaling message with a user message to the second device and not the call establishment. It is also a common sense thing not to terminate the call-set up if the signaling message is not communicated.

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Ranta, as set forth in the rejection, clearly discloses **placing the user message in the signaling message of a call-set up protocol.**

As such, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta to place the user message in the signaling message, and terminate the set-up of the call channel once the signaling message, i.e. **signaling message including user message**, has been communicated.

Such termination can be implemented through Lindsay's teachings as set forth above once the signaling message has been communicated. Therefore, the combination of Lindsay et al. and Ranta discloses terminating the set up of the call channel once the user message has been communicated, wherein the termination is being triggered/initiated by the communication of the user message.

b. Moreover, Linday et al fails to teach or suggest that such a termination occurs once a reply to the user message has been received without establishing a call, the terminating step being triggered by the receipt of the reply to the user message, as recited in claim 10 (remarks, pg. 8).

In response to argument [b], Examiner respectfully disagrees.

In addition to teachings set forth above, Linday also discloses sending a reply and/or ACK message back to the sender in order to indicate that the message has been received by the receiver, e.g. col. 27 L37-52, which is reproduced herein.

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1. A user station application sends a call originate request to the user station 102 over-the-air controller.
2. The user station 102 seizes an available time slot (such as, for example, time slot 302 in FIG. 3 or virtual time slot 618 in FIG. 6) in accordance with the protocol shown in FIG. 4 and/or 4A. If no time slot is acquired, the user station 102 times out and attempts to register and then acquire a time slot on another base station 104.
3. Upon successful time slot acquisition, the user station 102 responds to the specific poll message 402 with an ORIGINATE control traffic (CT-ORG) message. The CT-ORG message includes circuit reference (CREF) information.
4. The base station 104 responds to the CT-ORG message by sending a control traffic acknowledgment (CT-ACK) message back to the user station 102. (If no CT-ACK

As set forth above, the termination can occur at any time by both the user and/or the base station. In an event, the user receives the ACK message verifying that a message has been received by the receiver, the user can easily initiate/trigger the termination command as in Table 9-2 to release the connection.

As such, the combination of Lindsay and Ranta explicitly discloses termination occurring once the user message has been received without establishing a call, wherein the termination is triggered or initiated by the receipt of the user message.

The rationale for supporting the combination can be found in **KSR International Co. v. Teleflex Inc.**, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit, and **MPEP 2143. [EXEMPLARY RATIONALES:**

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Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" – choosing from a finite number of identified, predictable].

c. Ranta does not cure the deficiencies in Lindsay et al....such paging channel information or other information that is communicated on a broadcast channel cannot be equated with a user message that originates at a terminal rather than a base station. Moreover, such broadcast channels cannot be equated with a call channel (remarks, pg. 8).

In response to argument [c], Examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. "user message that originates at a terminal...") are not recited in the rejected claim(s).

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, applicant asserts that "such a broadcast channel cannot be equated with call channel...".

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In response, applicant should note that both the network and the call-set up method in both the application and the prior art, are the same. For example: the network comprises GSM, e.g. Lindsay, fig. 2A, applicant specification, pg. 4 lines 15-23.

Moreover, Ranta discloses the method of utilizing the spare fields of signaling message as in GSM standard 04.18, similar to applicant's specification, e.g. pg. 4 lines 14-21.

For the at least these reasons, the REJECTION IS MAINTAINED.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-3, 6-7, 10-12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1).

As per claim 1, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

- activating a request to set up a call channel (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1); and

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- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call, wherein the terminating step can be triggered/initiated at anytime (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24: terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field, and the process wherein the termination step is being triggered/initiated by the communication of the user message.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field and communicating the user message (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message and terminate the set-up of the call channel once the user message has been communicated.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied part(s) of the signaling message (Ranta, col. 2 L13-25).

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As per claim 2, Lindsay discloses the process wherein the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claim 3, Lindsay discloses the process wherein a user is authorized to access the dedicated memory by means of specific commands (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28: obviously it requires the commands to access the memory).

As per claim 6, Lindsay does not disclose the process wherein the size of the user message is limited to 35 eight-bit bytes at maximum (i.e. the user message is less than 35 bytes and/or in the range of 0-35 bytes).

Ranta discloses the process wherein the spare field (i.e. the user message that can be inserted into the spare field) is limited to 17 bytes (col. 3 L64 to col. 4 L10: i.e. 17 bytes is in the range of 0-35 bytes).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to limit the size to 35 bytes at maximum.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 1.

As per claim 7, Lindsay discloses the process wherein the user message is communicated in an enciphered form (i.e. encrypted, col. 20 L1-40).

As per claim 10, Lindsay discloses a method of sending a signaling messages through a transmission network (fig. 1-2), comprising:

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- activating a request to set up a call channel (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- performing a signaling stage comprising sending said signaling message (col. 18 L30-67, col. 20 L41 to col. 21 L12, col. 25 L62 to col. 26 L30, col. 24 L1-49, fig. 9 item #1);
- receiving a reply, i.e. ack, once the signaling message has been received (col. 27 L37-52); and
- terminating the setting up of the call channel once the signaling message has been communicated without establishing the call, wherein the terminating step can be triggered/initiated at anytime (col. 24 L30-50, col. 27 L36 to col. 28 L26, col. 30 L66 to col. 31 L24: terminating the call during and/or prior of the establishment of the call channel).

However, Lindsay does not disclose the process of placing a user message (i.e. information) in a spare field of a signaling message for setting up the call channel, said signaling message including a parameter to indicate the presence of said spare field, and the process wherein the termination step is being triggered/initiated by the receipt of the reply to the user message.

Ranta explicitly discloses placing information in a spare field of a signaling message for setting up the channel (note according to applicant specification, page 4, lines 15-24: the invention utilizes GSM standard 04.18) the signaling message includes an identifier (a parameter) to indicate the presence of said spare field and communicating the user message (col. 2 L41-58, col. 3 L63 to col. 4 L67, col. 5 L49-67, fig. 2).

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Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Ranta in order to place information and/or user message in a spare field of signaling message and terminate the set-up of the call channel once the reply to the user message has been received.

One of ordinary skilled in the art would have been motivated because it would have allowed the system to transmit information in an unoccupied part(s) of the signaling message (Ranta, col. 2 L13-25).

As per claim 11, Lindsay discloses the process wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message (col. 9 L56 to col. 10 L10; Ranta: col. 6 L3-28).

As per claims 12 and 15-16, they do not teach or further define over the limitations in claims 1-3, 6-7 and 10-11. Therefore claims 12 and 15-16 are rejected for the same reasons as set forth in claims 1-3, 6-7 and 10-11.

2. Claims 4-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindsay et al. (hereinafter Lindsay, US 6,301,242 B1) in view of Ranta (U. S. Patent No. 6,775,259 B1), and further in view of Miller, II (hereinafter Miller, US 5,600,707).

As per claim 4, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and the transmission network is a mobile telephone network (fig. 2, col. 5 L50 to col. 6 L35, fig. 2A, col. 9 L56 to col. 10 L43: mobile telephone network).

However, Lindsay does not disclose the process wherein the mobile telephone is used as modem.

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Miller explicitly discloses the process and apparatus, i.e. mobile device that can be used as a modem (col. 1 L30-55, col. 2 L26-61, fig. 1).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to use mobile telephone as a modem.

One of ordinary skilled in the art would have been motivated because it would have enabled communications (Miller, col. 1 L31-65).

As per claim 5, Lindsay discloses the process wherein the dedicated memory is in a mobile telephone and using ISDN as the transmission network (col. 6 L60-67).

However, Lindsay does not disclose the process wherein the dedicated memory is in an ISDN-type modem.

Miller explicitly discloses an ISDN-type modem (fig. 1, col. 1 L31-65, col. 2 L62 to col. 3 L22).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Lindsay in view of Miller in order to include the dedicated memory in an ISDN-type modem.

One of ordinary skilled in the art would have been motivated because it would have allowed data communications (Miller, col. 1 L31-65).

As per claims 13-14, they do not teach or further define over the limitations in claims 4-5. Therefore, claims 13-14 are rejected for the same reasons as set forth in claims 4-5.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pettersson et al., US 6,304,595 B1: Mobile Telephone Modems.
- b. Hameleers et al., US 6,377,799 B1: Interworking function in an internet protocol based radio telecommunications network.
- c. Schiefer et al., US 5,884,175: Handover following in a mobile radio system.
- d. Clarke et al., US 5,550,914: Communications Signalling network apparatus.
- e. Rosenthal et al., U. S. Patent No. 5,737,701: Automatic Authentication System.
- f. Wallenius, U. S. Patent No. 6,466,786 B1: Call setup in Mobile Communications.

Conclusion

The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

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THIS ACTION IS MADE NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/John Follansbee/
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